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IP 6141

3721

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : GATEWOOD et al.

Group Art Unit: 3721

Serial No. : 09/967,302

Filed : September 28, 2001

Examiner : T.M. Ho

For : LAMINATED PAPER STOCKS AND FLEXIBLE PACKAGING MADE THEREFROM

Date: January 7, 2003

Commissioner for Patents  
Washington, D.C. 20231

R. Kent

1/16/03

#8/Election

RESPONSE TO RESTRICTION REQUIREMENT

This is responsive to the Restriction Requirement dated December 13, 2002 in the above-identified application.

The Examiner has required that an election of invention be made between the following invention Groups: Group I, which the Examiner asserts, includes the product and method of making the product (Claims 1-23) and Group II, which the Examiner asserts, includes the process of using the product (Claim 24). Applicants hereby elect the invention of Group I (Claims 1-23) with traverse.

The Examiner argues that the inventions of Group I and II are distinct because the claimed product can be used in another materially different method, i.e. a method that does not require forming a package. The Examiner further asserts that the search required to examine the Group I claims is not the same as required for the examination of the Group II claim. Applicants respectfully disagree.

Claims 1-9 of the present invention are directed to laminated paper stock comprised of at least one biaxially oriented polymeric film; an adhesive material; and a paper substrate. Claims 10-16 are directed to flexible packaging for wrapping paper comprised of the same laminated paper stock claimed in claims 1-9. Claims 17-

23 are directed to methods of making laminated paper stock which comprise the steps of providing at least one biaxially oriented polymeric film and adhering the film to a paper substrate. Similarly, claim 24 is directed to a method of making flexible packaging for wrapping paper which comprises the steps of providing the laminated paper stock made in the same fashion as described in claims 17-23 and forming the packaging from the laminated paper stock.

Thus the present invention encompasses the (i) laminated paper stock, (ii) flexible packaging for wrapping paper made from the same laminated paper stock, (iii) methods for making the laminated paper stock and (iv) methods for making the flexible packaging from that same laminated paper stock. Whether or not the product can be the subject of another method of use claim is not relevant, because claim 24 is directed to a method of making flexible packaging using the same laminated paper stock that is the subject of claims 1-23.

The Manual of Patent Examining Procedure provides that restriction between patentably distinct inventions is proper when (1) the inventions are independent or distinct as claimed, and (2) unrestricted examination would seriously burden the Examiner. See MPEP 803. Neither criterion is met in the present case. As explained above, even if the laminated paper stock could be used in other products, the laminated paper stock must be of the same composition as described claims 1-23. Therefore, it is believed that the fields of search for the laminated paper stock, flexible packaging claims, as well as the method for making laminated paper stock claims overlap with the claims directed to making the flexible packaging and that Patent efficiencies will be furthered by unrestricted examination of the application.

For the foregoing reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement and

examine claims 1-24 together.

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Respectfully submitted,  
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